



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS/
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,029	10/18/2006	Hsun-Lang Chang	09541.0001	6882
22852 7590 12/05/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER MI, QIUWEN	
			ART UNIT 1655	PAPER NUMBER
			MAIL DATE 12/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,029

Applicant(s)

CHANG ET AL.

Examiner

Qiuwen Mi

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 11-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/3/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-11, and species *Pelargonium roseum*, in the reply filed on 11/6/07 is acknowledged. The traversal is on the ground(s) that search for all the claims is not a burden. This is not found persuasive because as indicated in the previous office action, there is no special technical feature between Groups I and II. They have different electronic resources and search queries, and searing for one subject matter will not necessarily lead to another. Applicant is reminded of the extensive literature search in biotechnology which is not co-extensive.

The requirement is still deemed proper and is therefore made FINAL.

Claims 9, and 11-38 are withdrawn from further consideration as being drawn to nonelected inventions.

Claims Pending

Claims 1-38 are pending. Claims 9, and 11-38 are withdrawn as they are directed toward a non-elected invention groups or species. Claims 1-8, and 10 are examined on the merits.

Specification/Abstract Objections

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often

Art Unit: 1655

used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant case, Applicant is required to delete "The present invention relates to" on line 1 of the Abstract to be more clear and concise. The letter of "a" in line 1 should be capitalized after the deletion. In addition, Applicant is requested to replace "said" in line 2 with "The".

Claim Objections

Claims 1-3, 6, and 7 are objected to because of the following informalities: The correct spelling of "tonkinesis" is "tonkinensis". Appropriate correction is required.

Claim Rejections –35 USC § 112, 2nd

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of claims 4-7 are rendered uncertain because the percentage amounts of the ingredients are not set forth in terms of either "by weight" or "by volume"

Art Unit: 1655

percentage amount of the total weight amount of the composition. The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

Claim Rejections –35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 8, and 10 are rejected under 35 USC § 102 (e) as being anticipated by Fong et al (US 2003/0134003 A1).

Applicant claims a composition comprising geranium oil and extractions from the root of *Sophora tonkinensis*.

Fong et al teach a composition comprising geranium oil and powder of roots of at least one plant selected from a group comprising *Sophora tonkinensis* etc (claim 51). Fong et al further teach that geranium oil is extracted from plant of the genus *Pelargonium* and species *roseum* (claim 21).

Therefore, the reference is deemed to anticipate the instant claim above.

Claim Rejections –35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fong et al (US 2003/0134003).

Applicant claims a composition comprising geranium oil and extractions from the root of *Sophora tonkinensis*.

Fong et al teach a composition comprising geranium oil and powder of roots of at least one plant selected from a group comprising *Sophora tonkinensis* etc (claim 51). Fong et al also teach that dried *Sophora* roots are ground into powder and filtered through 40 mesh [0033], further extracted with ethanol to obtain *Sophora* paste. The paste was then dissolved with distilled water, glycerine and gelatin (excipients) are added [0034]. The *Sophora* paste may be mixed with glycerol soyllecithin (excipients) and then mixed with geranium oil to produce a form of emulsion for oral intake. Cyclodextrin (excipients) may also be used to make tablets or pills enclosing the composition [0035]. Fong et al further teach that geranium oil is extracted from plant of the genus *Pelargonium* and species *roseum* (claim 21). Fong et al also teach that the

Art Unit: 1655

composition can also take on the form of an oil capsule, tablets, pills, and paste etc to be administered orally.

Fong et al do not teach the claimed amount of geranium oil, *Sophora tonkinensis*, and excipient in the composition. Fong et al do not explicitly teach geranium oil powder.

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the inventions of Fong et al since Fong et al teach that the can be used as a supporting composition in cancer treatment (see Title) since the composition yielded beneficial results in supporting cancer treatment, one of ordinary skill in the art would have been motivated to make the modifications. It would also have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to take on the form powder for geranium oil, since Fong et al teach that the composition can take on the form of an oil capsule, tablets, pills, and paste etc to be administered orally, and powder is a conventional pharmaceutical form that is well known in the art. Regarding the limitation to the amount of the components in the composition, the result-effective adjustment in conventional working parameters is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan, which is dependent on the condition of the patient.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Art Unit: 1655

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Qiuwen Mi


MICHELE FLOOD
PRIMARY EXAMINER